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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,396	04/17/2001	John B. Ferber	08011.0134	6037
22852	7590	01/29/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			YOUNG, JOHN L	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/835,396</b>	Applicant(s) <b>Ferber et al.</b>	Examiner <b>John Young</b> Art Unit <b>3622</b>
		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Apr 17, 2001

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-7 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-7 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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## **FIRST ACTION REJECTION**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM REJECTION — 35 U.S.C. §103( a )**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter

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pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are rejected under 35 U.S.C. §103( a ) as being obvious over Brooke, Jr. et al. US 6,424,884 (07/23/2002) [US f/d: 03/03/1999] (herein referred to as "Brooke").

As per claim 1, Brooke (the ABSTRACT; FIG. 1; FIG. 4; FIG. 5; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67 & col. 9, ll. 1-30) discloses the inherent inventive concept of claim 1. For example Brooke (FIG. 5) discloses: "6.50 Credit. . ." The Examiner interprets this disclosure as suggesting "one electronic coupon. . ."

(NOTE: It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989), and "In considering disclosures of reference patents, it is pertinent to point out not only specific teachings of the patent but also the reasonable inferences which one skilled in the art would logically draw therefrom.". (See *In re Shepard*, 138 USPQ 148 (CCPA 1963)).

Brooke lacks an explicit recitation of the "one electronic coupon. . ." even though Brooke (the ABSTRACT; FIG. 5; col. 1, ll. 5-12; col. 1, ll. 36-45; col. 1, ll. 55-65; col. 2, ll. 35-67; col. 5, ll. 9-20; col. 6, ll. 33-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll.

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1-30; and the whole document) reasonably suggests same. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the cited disclosure of Brooke would have been selected in accordance with showing the electronic coupon features of the current invention because selection of such features would have provided means for “[tracking] purchasing habits of a customer . . . and reward purchasers with incentives. . . .” such as coupons. (see Brooke (col. 1, ll. 60-65)).

As per dependent claims 2-5, Brooke shows the method of claim 1 and subsequent base claims depending from claim 1.

Brooke (the ABSTRACT; FIG. 1; FIG. 4; FIG. 5; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67 & col. 9, ll. 1-30) shows elements that suggest the elements and limitations of claims 2-5; however,

Brooke lacks explicit recitation of the elements and limitations of claims 2-5, even though the disclosure of Brooke suggests same. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the cited disclosure of Brooke would have been selected in accordance with showing the electronic coupon features of the current invention because selection of such features would have provided means for “[tracking] purchasing habits of a customer . . . and reward purchasers with incentives. . . .” such as coupons. (see Brooke (col. 1, ll. 60-65)).

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Independent claim 6 is rejected for substantially the same reasons as independent claim 1.

Independent claim 7 is rejected for the same reasons as independent claim 1.

### **CONCLUSION**

3. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

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(Ferber et al.)

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young  
Primary Patent Examiner

January 23, 2004